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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,437	12/21/2000	Bruce A. Hay	PC11862A	8404

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EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 07/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/747,437

Applicant(s)  
Hay

Examiner  
David Lukton

Art Unit  
1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) 5-10, 18-20, 22-24, 26, and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-17, 21, and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 5 6) ☐ Other:

Applicants' election of Group II is acknowledged (claims 1-4, 11-17, 21, 25, limited to compounds of G2), as is the elected specie.

\*

The specification is objected to. In several of the chemical structures, hydrogen atoms are missing from the amide bonds and/or the indole nitrogen. See for example, page 7, page 20 (line 16+), page 21 (first structure) and pages 28, 29.

\*

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application Serial No. 09/618029. Although the conflicting claims are not identical, they are not patentably distinct from each other; there is overlap of the claimed genera. [This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented].

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d)

\*

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 11-17, 21, 25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification describes a number of assays which one could potentially carry out. It is asserted that the compounds are effective to increase secretion of growth hormone, gastrin, and glucagon. However, no results are presented; accordingly, the assumption is that all compounds are inactive in all assays. As it happens, in pharmacology one cannot determine the activity (if any) of a compound merely by viewing its structure. "Undue experimentation" would be required to determine which, if any, of the claimed compounds will be effective to increase secretion of growth hormone, gastrin, or glucagon. (It is suggested that at least some *in vitro* data be provided).

In the event that *in vitro* data is provided, the rejection will be maintained against those claims that are drawn to a "pharmaceutical composition". The term "pharmaceutical composition" implies an assertion of therapeutic efficacy. *In vitro* data on receptor antagonism or receptor stimulation is not predictive of therapeutic efficacy, or even,

necessarily, of *in vivo* activity. As stated in *Ex parte Forman* (230 USPQ 546, 1986) the factors to consider in evaluating the need (or absence of need) for "undue experimentation" are the following: quantity of experimentation necessary, amount of direction or guidance presented, presence or absence of working examples, nature of the invention, state of the prior art, relative skill of those in that art, predictability or unpredictability of the art, and breadth of the claims. Consider the following:

- Torsello, Antonio (*Endocrinology* **143** (5) 1968, 2002) pertains to growth hormone, and discloses that stimulation of the growth hormone secretagogue receptor does not correlate with capability to stimulate GH secretion.
- McFadyen "Modifications of the cyclic mu receptor selective tetrapeptide Tyr-c[D-Cys-Phe-D-Pen]NH<sub>2</sub> (Et): effects on opioid receptor binding and activation" (*Journal of Peptide Research* (2000 Mar) **55** (3) 255-61) reported on modifications to the title peptide. The reference discloses that potency changes did not always correlate with affinity, suggesting that the conformation required for binding and the conformation required for activation of the opioid receptors are different.
- Keith, "mu-Opioid receptor internalization: opiate drugs have differential effects on a conserved endocytic mechanism in vitro and in the mammalian brain" (*Molecular Pharmacology* **53** (3) 377-84, 1998) discloses that the different effects of individual agonists are not correlated with their potencies for receptor activation and that a variety of clinically important agonists differ significantly in their relative abilities to stimulate the rapid internalization of opioid receptors.
- Xiao (*Biochemistry* **40**, 2860, 2001) has looked at the relationship between cAMP production in cells, and *in vivo* activity. While some degree of correlation was noted, a 1:1 correspondence was absent. As stated on page 2864, col 2, "the results indicated that these functions may be dissociated, mostly likely to additional determinantants of *in vivo* activity...". For example, as conveyed in table 6, Phe'-GLP-1 exhibited decreased receptor activation compared with WT GLP-1 along with decreased *in vivo* insulintropic activity; by contrast, Acetyl-GLP-1 exhibited decreased receptor activation compared with WT GLP-1 accompanied by an increase